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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,754	05/31/2001	Bijan Tadayon	111325-62	5707
22204	7590	11/03/2003	EXAMINER	
NIXON PEABODY, LLP 8180 GREENSBORO DRIVE SUITE 800 MCLEAN, VA 22102			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/867,754

Applicant(s)

TADAYON ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This is in response to a letter for patent filed on May 31st, 2001 in which claims 1-27 are presented for examination. Claims 1-27 are pending in the letter.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to recording digital work, classified in class 380, subclass 40.
 - II. Claims 12-26, drawn to marking portion of digital content, classified in class 713, subclass 176.
 - III. Claims 27-29, drawn to distribution of digital content, classified in class 380, subclass 201.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention are patentably distinct. The subcombination has separate utility such as recording digital work, marking portion of digital content, distribution of digital content.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I and II is not required for Group III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mark Kaufman on October 29, 2003 a provisional election was made without traverse to prosecute the invention of III, claims 27-29. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1-26 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8. Claims 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. .

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 1 only recites an abstract idea. The recited step of receiving a request for downloading digital content ... etc. do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, it not within the technological arts as explained above, claim 1 deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (U.S. PG Pub 2002/0059363) in view of Gold et al (U.S. Patent No. 6,304,659).

11. As per claim 27, Katz et al teach method for distributing digital works comprising: receiving a request for downloading digital content data, and downloading a portion of the content data (*see abstract, paragraphs 0041*). Katz et al fail to teach associating a flag element with the content data, the flag element having memory registers for saving demarcation flags, the registers corresponding to memory addresses of the addressable memory; and manipulating the flag element to place a flag in a memory register corresponding to a memory address indicating the downloaded portion of the content. However, Gold et al teach an inventive concept of associating a flag element with the content data, the flag element having memory registers for saving demarcation flags, the registers corresponding to memory addresses of the addressable memory; and manipulating the flag element to place a flag in a memory register corresponding to a memory address indicating the downloaded portion of the content (*see abstract, column 1 lines 41-61, 3 lines 39-4 line 8*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify Katz et al's inventive concept to include Gold

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inventive concept of associating a flag element with the content data, the flag element having memory registers for saving demarcation flags, the registers corresponding to memory addresses of the addressable memory; and manipulating the flag element to place a flag in a memory register corresponding to a memory address indicating the downloaded portion of the content because this would have enhance the flexibility for accomplishing analogous distributing of digital works without diminishing the control over the digital work by the content owner.

12. As per claim 27, Katz et al teach method wherein the downloading step comprises downloading a portion of the content data that will fit into available memory of a device receiving the content data (*see paragraphs 0004*).

13. As per claim 27, Katz et al teach method further comprising the step of determining the available memory in the device receiving the content data and wherein the manipulating step comprises placing flag elements in memory registers corresponding to memory addresses demarcating a portion of the content data that corresponds to the available memory of the device receiving the content data and wherein the downloading step comprises downloading a portion of the content data in memory addresses corresponding to the demarcated portion (*see abstract, paragraphs 0041*).

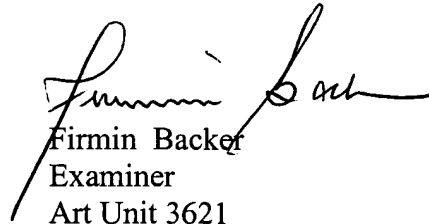
Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
Art Unit 3621

October 29, 2003